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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,306	08/25/2005	Benoit Thevenot	09669/056001	6389

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EXAMINER

KIM, TAE W

ART UNIT PAPER NUMBER

2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/528,306

Applicant(s)

THEVENOT, BENOIT

Examiner

Tae W. Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment filed on January 3, 2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8, 3, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (US 6440773 B1).

Re claim 8: Usami discloses a card like object comprising:

a top face and a bottom face (fig 1, fig 2: top face is shown);

a contactless chip (fig 11 part 1126, fig 17 part 1713, col 3 lines 36-38, col 9 lines 9-18: capacitor chip, col 10 lines 25-31);

a contact chip (fig 31 part 3134, fig 30 part 3024, col 1 lines 16-20, col 3 lines 34-36 & 49-51, col 14 lines 9-11); and

an antenna electrically connected to contactless chip (figs 42 & 43),

wherein cavity is formed on the top face (fig 34, col 1 lines 42-47: "milling a card substrate ... to form a recess,"); and

wherein the contactless chip and the contact chip are located on the same card (fig 11 parts 1121 & 1126, fig 41 parts 4151 & 4153, col 1 lines 58-60).

However, Usami does not disclose or fairly suggest that the contactless chip and the contact chip are located in the cavity.

Usami however discloses the step of mounting a semiconductor chip (fig 31 part 3134) in a cavity (i.e. milled recess) on a generic IC card (col 1 lines 26-47).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the separate teachings of Usami to place both contactless chip and the contact chip are in the cavity for the purpose of simplifying the process of making a hybrid card that contains both contactless chip and contact chip.

Re claims 3: Usami discloses the card like object of claim 8, wherein the antenna is connected to contactless chip with a conductive adhesive (fig 1 part 19, fig 41, col 1 lines 60-61).

Re claims 7: Usami discloses the card like object of claim 8, wherein the contact chip and the contactless chip are in a side-by-side configuration (fig 11 parts 1121 & 1126, fig 41 parts 4151 & 4153, col 1 lines 58-60).

Re claims 9: Usami discloses the card like object of claim 8, wherein the top face is at least partially graphically personalized (fig 2, col 7 lines 42-45).

Re claims 10: Usami discloses the card like object of claim 8, wherein the antenna is embedded within the card like object (fig 1 parts 15 & 16, col 6 lines 61-67).

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (US 6440773 B1) in view of Carpier (US 6568600 B1).

Re claims 2: Usami discloses the card like object of claim 8, wherein the antenna is connected to the contactless chip.

However, Usami does not disclose or fairly suggest that the connecting means is a conductive track.

Capier however discloses that the connecting means is a conductive track (col 2 lines 39-46).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to add Capier's a conductive track to Usami's card like object for the purpose of implementing a reliable and inexpensive connection.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (US 6440773 B1) in view of Laroche (US 6566163 B1).

Re claims 4: Usami discloses the card like object of claim 8, wherein the antenna is connected to the contactless chip.

However, Usami does not disclose or fairly suggest that the connecting means is a metallic wire.

Laroche however discloses that the connecting means is a metallic wire (abstract).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to add Laroche's a metallic wire to Usami's card like object for the purpose of implementing a reliable and inexpensive connection to the antenna.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (US 6440773 B1) in view of Fujikawa (US 20010050138 A1).

Re claims 5: Usami discloses the card like object of claim 8, wherein the antenna is connected to the contactless chip.

However, Usami does not disclose or fairly suggest that the connecting means is a liquid.

Fujikawa however discloses that the connecting means is a liquid (par. 0009).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to add Fujikawa's liquid connecting means to Usami's card like object for the purpose of implementing a reliable and inexpensive connection between the antenna and the chip.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (US 6440773 B1) in view of Wallace (US 20030183914 A1).

Re claims 6: Usami discloses the card like object of claim 8 comprising the contact chip and the contactless chip.

However, Usami does not disclose or fairly suggest that the chips are in a stacked configuration.

Wallace however discloses that the chips are in a stacked configuration (par. 0004).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Wallace's teaching that the chips are in a stacked configuration to Usami's card like object for the purpose of reducing the footprint of the chips on

the surface of the substrate, which can further promote the overall reduction of the form-factor for the card like object.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive.

By combining the teachings of Usami, the concept of contactless chip and the contact chip located in a cavity formed on a top face of the card is rendered obvious.

In contrary to the applicant's argument, Usami discloses a card like object that includes a top face with a cavity formed thereon (fig 34, col 1 lines 42-47: "milling a card substrate ... to form a recess,").

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae W. Kim whose telephone number is 571-272-5971. The examiner can normally be reached on Mon-Fri 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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